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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/258,123      02/26/99      BURGER

R      107227.00102

002779      WM01/0223  
BLANK ROME COMISKY & MCCAULEY  
WIGMAN COHEN LEITNER & MYERS  
THE FARRAGUT BUILDING SUITE 1000  
900 17TH STREET NW  
WASHINGTON DC 20006

EXAMINER

ROBINSON, G

ART UNIT

PAPER NUMBER

2177

DATE MAILED:

02/23/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/258,123

Applicant(s)

Berger et al.

Examiner

Greta Robinson

Group Art Unit  
2177



☒ Responsive to communication(s) filed on Feb 26, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-84 is/are pending in the application

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-84 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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### **DETAILED ACTION**

1. Claims 1-84 are pending in the present application.

#### ***Drawings***

2. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Note form PTO 948 for Draftsperson's review.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

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4. Claims 13-39 and 68-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitchell et al. US Patent 5,963,966 in view of Stern US Patent 6,161,107.

With respect to claim 13, **Mitchell et al.** teaches a persistent electronic storage medium for storing a document in electronic form, the document having a plurality of pages, the medium having written thereon:

(A) plurality of viewable files, each file representing one of the pages of the document and preserving a printed format of said one of the pages [col.7 lines 42-53 “*Each HTML page (typically a separate file, but multiple pages can be accommodated in a single file)*”];

(B) an index representing an organization of the document [note “*indexing*” figure 2; col.2 lines 59-65 “*indexing schemes*”; col.7 lines 32-41; and col.13 line 64 through col.14 line 7]; and

(C) software to view the viewable files and to search through the viewable files in accordance with the index [col.13 line 64 through col.14 line 24; col.1 lines 57-64; col.8 lines 61-67; and col.9 lines 7-32].

Although Mitchell teaches storing a document in electronic form as cited above; he does not explicitly specify the electronic storage medium is of the persistent type. **Stern** teaches that persistence is the mechanism for storing the state of a component that has been captured in one format such as by a scanner or fax and converted into another format to be viewed on a monitor for further analysis [see: col.11 lines 30-46; also note figure 7 and abstract]. It would have been obvious to one of ordinary skill at the time of the invention to have combined Stern with Mitchell

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et al because a persistent storage such as ROM would allow data captured to remain intact when the power to the device is turned off.

5. With respect to claims 14-16:

(Claim 14) wherein the viewable files are bitmap files [Mitchell et al., col.8 lines 19-35].

(claim 15) wherein the bitmap files have a compression applied thereto [Mitchell et al., col.9 line 33 through col.10 line 30; col.11 line 25 through col.12 line 121].

(Claim 16) wherein the compression is a lossy compression [Mitchell et al., note “lossy compression” col.10 lines 12-18; also see col. 11 line 25 through col.12 line 12].

6. With respect to claim 17:

wherein the document is organized under a plurality of headings; and

the index associates each heading with a page on which the heading appears [Mitchell et al., figure 4; also note figures 5 and 8; see col.7 lines 7-26; col.8 lines 5-18].

7. With respect to claims 18-20:

(Claim 18) wherein the index associates each heading with a first page on which the heading appears [Mitchell et al., col.7 lines 42-67].

(claim 19) wherein the software comprises software to receive a typed name of a heading and to receive the page associated with that heading in the index [Mitchell et al., figure 5].

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(Claim 20) wherein the software comprises software to show a list of headings, to receive a selection of a heading from the list and to retrieve the page associated with the heading in the index [Mitchell et al., figure 5 note table of contents].

8. With respect to claims 21 and 22:

(Claim 21) wherein the software is written in a device-independent language ..... and  
(Claim 22) wherein the device-independent language is JAVA [See: Stern col.10 line 47 through col. 11 line 23].

Although Mitchell et al. teaches the invention as cited above, they do not specify that the software is written in a device-dependent language. Stern teaches that the software is written in JAVA a device-independent language. It would have been obvious to one of ordinary skill at the time of the invention to have combined Mitchell and Stern because the system architecture provides a framework for interaction between different objects over the Internet by using HTTP Web servers and existing web browsers. Also the technology of the JAVA language enables one to communicate with other applications over the World Wide Web.

9. With respect to claims 23 and 24:

(Claim 23) wherein the software is written to run within a World Wide web browser ...  
(Claim 24) wherein a distribution file for the World wide Web browser is written on the medium [Mitchell et al., col.6 line 63 through col.7 line 14].

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10. With respect to claim 25:

(A) a persistent electronic storage medium having written thereon [see Stern: col.11 lines 30-46; also note figure 7 and abstract];

(i) a plurality of viewable files, each viewable file representing one of the pages of the document and preserving a printed format of said one of the pages [Mitchell, col.7 lines 42-53 “*Each HTML page (typically a separate file, but multiple pages can be accommodated in a single file*”];

(ii) an index representing an organization of the document [Mitchell, note “*indexing*” figure 2; col.2 lines 59-65 “*indexing schemes*”; col.7 lines 32-41; and col.13 line 64 through col.14 line 7; and

(iii) software to view the viewable files and to search through the viewable files in accordance with the index [Mitchell, col.13 line 64 through col.14 line 24; col.1 lines 57-64; col.8 lines 61-67; and col.9 lines 7-32]; and

(B) a computer for accessing the medium, running the software and allowing the user to interact with the software [see: Mitchell et al., col.13 line 64 through col.14 line 24; col.1 lines 57-64; col.8 lines 61-67; and col.9 lines 7-32].

Although Mitchell teaches storing a document in electronic form as cited above; he does not explicitly specify the electronic storage medium is of the persistent type. Stern teaches that persistence is the mechanism for storing the state of a component that has been captured in one format such as by a scanner or fax and converted into another format to be viewed on a monitor

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for further analysis [see: col.11 lines 30-46; also note figure 7 and abstract]. It would have been obvious to one of ordinary skill at the time of the invention to have combined Stern with Mitchell et al because a persistent storage such as ROM would allow data captured to remain intact when the power to the device is turned off.

11. With respect to claims 26-28:

(Claim 26) wherein the viewable files are bitmap files [Mitchell, col.8 lines 19-35].

(claim 27) wherein the bitmap files have a compression applied thereto [Mitchell, col.9 line 33 through col.10 line 30]

(Claim 28) wherein the compression is a lossy compression [Mitchell, col.10 lines 12-18; col.11 line 25 through col.12 line 12].

12. The limitations of claims 29-35 have been addressed above in claims 17-24; therefore they are rejected under the same rationale.

13. With respect to claims 36-39:

(Claim 36) the medium is installed on a server of a network; and  
the computer is connected to the network to access the medium on the server ... (Claim 37)  
wherein the network is a local area network ... (Claim 38) wherein the network is a virtual private network ... (Claim 39) wherein the network is the Internet [Note Mitchell et al cover figure and



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background of the invention col.1; the medium being installed on a network server or LAN is all within the scope of both Mitchell and Stern].

14. The limitations of claims 68-84 have been addressed above in claims 13-24 and 25-28, except for the following: a reverse side viewable file, highlighting, and viewing additional information such as a bill [Mitchell, col.9 lines 30-32, special formats col.7 lines 42-53; a browser is used on the network with the ability to link to additional material see figures 3, 5, 7, and 9A].

15. Claims 1-9, 12, 40-50 and 53-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitchell et al. US Patent 5,963,966 in view of Barrett et al. US Patent 4,918,588.

With respect to claim 1, **Mitchell et al.** teaches a method of providing a document in electronic form, the document having a plurality of pages, the method comprising:

(C) providing page-heading data representing an organization of the document;

(D) parsing the page-heading data to produce an index;

(E) providing software to view the viewable files and to search through the viewable files in accordance with the index; and

(F) providing the plurality of viewable files, the index and the software in persistent storage [Mitchell et al., figure 5, col.7 line 6 through col.8 line 36]. Although Mitchell et al.

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teaches the invention as cited above he does not specifically teach *step (a) a print queue for producing the document in a printed format and converting the print queue into a plurality of viewable files*. **Barrett et al.** teaches a print queue [see: figure 3 element (344, and 346); col.11 line 20 through col.12 line 20]. It would have been obvious to one of ordinary skill at the time of the invention to have combined Mitchell et al. and Barrett et al. because it would allow hard copies of the electronic documents to be printed.

16. With respect to claim 2:

the printing data in the print queue comprise data to be rasterized to produce the document;

step (b) comprises rasterizing the data to be rasterized; and

the viewable files are bitmap files [Mitchell et al. see figure 1 "*Raster-to-Vector Conv Extract Text from Graphics*"; also note rasterizing the data is a part of the OCR or image process].

17. With respect to claims 3-5:

(Claim 3) wherein the data to be rasterized comprises PostScript data [Mitchell et al., inherent of process see figure 1].

(Claim 4) wherein step (b) comprises applying compression to the bitmap files [Mitchell et al., col.10 lines 12-18].

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(Claim 5) wherein the compression is a lossy compression [Mitchell et al., col.10 lines 12-18].

18. With respect to claim 6:

the document is organized under a plurality of headings; and  
the index associates each heading with a page on which the heading appears [Mitchell et al., see figures 2-5].

19. With respect to claims 7-9:

(Claim 7) wherein the index associates each heading with a first page on which the heading appears [Mitchell et al., col.7 line 42 through col.8 line 35]

(Claim 8) wherein the software comprises software to receive a typed name of a heading and to receive the page associated with that heading in the index [Mitchell et al., col.11 lines 5-33; col.13 line 64 through col.14 line 24].

(Claim 9) wherein the software comprises software to show a list of headings, to receive a selection of a heading from the list and to receive the page associated with that heading in the index [Mitchell et al., figures 4 and 5].

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20. With respect to claim 12:

wherein the software is written to run within a World Wide Web browser [Mitchell et al., col.6 line 63 through col.7 line 14].

21. With respect to claim 40, a method of providing a page of a document in electronic form, the document having a plurality of pages with one or more items on each page, the page having a selected item thereon, the method comprising;

(A) providing page-heading data ... (b) parsing the page-heading data to determine a page on which the selected item is located and a position of the selected item on the page and to output highlighting information representing the position ... (c) providing a print queue of printing data for producing the document in a printed format ... (d) converting the print queue into a viewable file representing the page in said printed format, without an intermediary step of producing a hard copy of the page ... (e) providing software to view the viewable file and to highlight the position of the selected item on the page ... (f) providing the viewable file, the highlighting information and software on persistent storage [Mitchell et al., figure 4 lines 25-35; col.6 lines 51-58; col.9 lines 30-32 “clicking on the highlighted page”; note parsing col.7 lines 32-41; col.11 lines 7-9; also see figures 8 and 5; Note Barrett et al. teaches a print queue as cited under claim 1, see figure 3 element (344, and 346) and col.11 line 20 through col.12 line 20].

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22. With respect to claim 41:

determining a reverse-side page corresponding to the page determined in step (b) ....

[Mitchell et al., col.7 lines 42-53 “special formats”].

23. With respect to claim 42:

wherein the software comprises software for selectively viewing the viewable file either with or without the selected item highlighted [Mitchell col.9 lines 30-32].

24. With respect to claims 43-46:

(Claim 43) wherein the software comprises software for viewing additional material which is associated with the selected item but which is not included in the document ... (Claim 44) wherein the additional material comprises a link associated with the selected item ...[note Mitchell, cover figure browser allows one to link to additional material];

(Claim 45) wherein the additional material comprises a link to view the viewable file [Mitchell, figure 9];

(Claim 46) wherein the link permits selection of the viewable file with or without highlighting for the selected item [Mitchell, col.9 lines 30-32].

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25. With respect to claims 47-50:

(Claim 47) the printing data in the print queue comprise data to be rasterized to produce the document ... [Mitchell et al. see figure 1 "*Raster-to-Vector Conv Extract Text from Graphics*"; also note rasterizing the data is a part of the OCR or image process].

(Claim 48) wherein the data to be rasterized comprises PostScript data [Mitchell et al., inherent of process see figure 1].

(Claim 49) wherein step (d) comprises applying compression to the bitmap file [Mitchell et al., col.10 lines 12-18].

(Claim 50) wherein the compression is a lossy compression [Mitchell et al., col.10 lines 12-18].

26. The limitations of claims 53-63, 66 and 67 have been addressed above in claims 12 and 40-50; therefore they are rejected under the same rationale.

27. Claims 10, 11, 51, 52, 64 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitchell et al. US Patent 5,963,966 in view of Barrett et al. US Patent 4,918,588 as applied to claim 1-9 above, and further in view of Stern US Patent 6,161,107.

Although Mitchell et al. and Barrett et al teach the invention substantially as cited in claims 1-9 above, with respect to claims 10 and 11, they do not specify that the software is written in a device-dependent language. Note claims 10 and 11: "wherein the software is written

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in device-independent language” and (claim 11) “wherein the device-independent language is JAVA” [See: Stern col.10 line 47 through col. 11 line 23].

Stern teaches that the software is written in JAVA a device-independent language. It would have been obvious to one of ordinary skill at the time of the invention to have combined Mitchell, Barrett et al., and Stern because the system architecture provides a framework for interaction between different objects over the Internet by using HTTP Web servers and existing web browsers. The technology of the JAVA language enables one to communicate with other applications over the World Wide Web.

28. The limitations of claims 51, 52, 64, and 65 parallel claims 10 and 11; therefore they are rejected under the same rationale.

### ***Conclusion***

29. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Fueki** US Patent 5,339,412

**Dent et al.** US Patent 6,128,603

**Dunworth et al.** US Patent 5,930,474

**Barrett et al.** US Patent 4,918,588

**Edmunds** US Patent 6,006,281

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**Rowe et al.** US Patent 5,819,301

30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greta Robinson whose telephone number is (703)308-7565. The examiner can normally be reached Monday through Friday from 7:30 AM to 4:00 PM. If any attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene, can be reached at (703) 305-9790.

**Any response to this action should be mailed to:**

**BOX AF**

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**or faxed to:**

(703)308-6306, (for formal communications; please mark "EXPEDITED PROCEDURE") **Or:** (703)308-6606, (for informal or draft communications, please label "PROPOSED" or "DRAFT"). Hand delivered responses should be brought to Crystal Park II, 2021 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)305-9600.

Greta Robinson



February 20, 2000